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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,792	01/23/2001	Craig A. Lewis	07703-327001 / WCR0117	2248
26211	7590	08/27/2004	EXAMINER	
FISH & RICHARDSON P.C. 45 ROCKEFELLER PLAZA, SUITE 2800 NEW YORK, NY 10111			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,792

Applicant(s)

LEWIS ET AL.

Examiner

John L Young

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/23/2004.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

NON-FINAL REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-48 & 71-72 are rejected under 35 U.S.C. §103(a) as being obvious over Inamitsu et al. US 6,367,696 (04/09/2002) [US f/d: 02/04/2000] (herein referred to as "Inamitsu ").

As per independent claim 1, Inamitsu (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; col. 1, ll. 30-67; col. 2, ll. 1-67; col. 3, ll. 1-20; col. 4, ll. 9-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-67) implicitly shows all of the elements of claim 1; however,

Inamitsu lacks an explicit recitation of some of the elements and limitations of claim 1 (e.g., Inamitsu lacks explicit recitation of “validating cash or a card. . .”).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inamitsu cited above implicitly shows of “validating cash or a card. . .”; and it would have been obvious to modify and interpret the disclosure of Inamitsu cited above as showing of “validating cash or a card. . .”, because modification and interpretation of the cited disclosure of Inamitsu would have provided means to “*offer products or service free of charge. . .*” (see Inamitsu (col. 3, ll. 5-20)) based on the motivation to modify Inamitsu so that “*a discount rate is set and stored for each kind of product or service and the discount is by the discount rate . . . and when the personal information meets prescribed conditions, added benefit is offered. . .*” (see Inamitsu (col. 3, ll. 5-20)).

As per claims 2-24 & 71-72, Inamitsu shows the method of claim 1 and subsequent base claims depending from claim 1.

Inamitsu (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; col. 1, ll. 30-67; col. 2, ll. 1-67; col. 3, ll. 1-20; col. 4, ll. 9-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-67) implicitly shows all of the elements of claims & 71-72; however,

Inamitsu lacks an explicit recitation of some of the elements and limitations of claims & 71-72.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims & 71-72 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inamitsu cited above implicitly shows all of the elements and limitations of claims & 71-72; and it would have been obvious to modify and interpret the disclosure of Inamitsu cited above as showing shows all of the elements and of claims & 71-72, because modification and interpretation of the cited disclosure of Inamitsu would have provided means to "*offer products or service free of charge. . . .*" (see Inamitsu (col. 3, ll. 5-20)) based on the motivation to modify Inamitsu so that "*a discount rate is set and stored for each kind of product or service and the discount is by the discount rate . . . and when the personal information meets prescribed conditions, added benefit is offered. . . .*" (see Inamitsu (col. 3, ll. 5-20)).

Independent claim 25 is rejected for substantially the same reasons as independent claim 1.

As per claims 26-48, Inamitsu shows the method of claim 25 and subsequent base claims depending from claim 25.

Inamitsu (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; col. 1, ll. 30-67; col. 2, ll. 1-67; col. 3, ll. 1-20; col. 4, ll. 9-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7,

ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-67) implicitly shows all of the elements of claims 26-48; however,

Inamitsu lacks an explicit recitation of some of the elements and limitations of claims 26-48.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 26-48 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inamitsu cited above implicitly shows all of the elements and limitations of claims 26-48; and it would have been obvious to modify and interpret the disclosure of Inamitsu cited above as showing shows all of the elements and of claims 26-48, because modification and interpretation of the cited disclosure of Inamitsu would have provided means to "*offer products or service free of charge. . . .*" (see Inamitsu (col. 3, ll. 5-20)) based on the motivation to modify Inamitsu so that "*a discount rate is set and stored for each kind of product or service and the discount is by the discount rate . . . and when the personal information meets prescribed conditions, added benefit is offered. . . .*" (see Inamitsu (col. 3, ll. 5-20)).

3. Claims 49-70 are rejected under 35 U.S.C. §103(a) as being obvious over Tedesco et al. US 6,161,059 (12/12/2000) (herein referred to as "Tedesco") in vie of Inamitsu.

As per claim 49, Inamitsu implicitly shows most of the elements and limitations of the device of claim 49; however,

Inamitsu lacks explicit recitation of “a coin mechanism connected to the validating means. . . .”

Tedesco (col. 4, ll. 60-67; and col. 5, ll. 1-10) shows “a coin mechanism” connected to the validating means. . . .”

Tedesco proposes “coin mechanism” modifications that would have applied to the device and method of Inamitsu. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Tedesco with the teachings of Inamitsu because such combination would have provided means for *“permitting customers to participate in a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.”* (See Tedesco (col. 2, ll. 20-27)).

As per claims 50-62, Inamitsu in view of Tedesco shows the device of claim 49 and subsequent base claims depending from claim 49.

Inamitsu in view of Tedesco as cited above in both references implicitly shows all of the elements of claims 50-62; however,

Inamitsu in view of Tedesco lacks an explicit recitation of some of the elements and limitations of claims 50-62.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 50-62 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure

of Inamitsu cited above implicitly shows all of the elements and limitations of claims 50-62; and it would have been obvious to modify and interpret the disclosure of Inamitsu cited above as showing shows all of the elements and of claims 50-62, because modification and interpretation of the cited disclosure of Inamitsu would have provided means to “*offer products or service free of charge. . . .*” (see Inamitsu (col. 3, ll. 5-20)) based on the motivation to modify Inamitsu so that “*a discount rate is set and stored for each kind of product or service and the discount is by the discount rate . . . and when the personal information meets prescribed conditions, added benefit is offered. . . .*” (see Inamitsu (col. 3, ll. 5-20)) and because the combination of the Inamitsu and Tedesco references would have provided means for “*permitting customers to participate in a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.*” (See Tedesco (col. 2, ll. 20-27)).

Independent claim 63 is rejected for substantially the same reasons as independent claim 49.

As per claims 64-70, Inamitsu in view of Tedesco shows the device of claim 63 and subsequent base claims depending from claim 63.

Inamitsu in view of Tedesco as cited above in both references implicitly shows all of the elements of claims 64-70; however,

Inamitsu in view of Tedesco lacks an explicit recitation of some of the elements and limitations of claims 64-70.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 64-70 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inamitsu cited above implicitly shows all of the elements and limitations of claims 64-70; and it would have been obvious to modify and interpret the disclosure of Inamitsu cited above as showing shows all of the elements and of claims 64-70, because modification and interpretation of the cited disclosure of Inamitsu would have provided means to "*offer products or service free of charge. . . .*" (see Inamitsu (col. 3, ll. 5-20)) based on the motivation to modify Inamitsu so that "*a discount rate is set and stored for each kind of product or service and the discount is by the discount rate . . . and when the personal information meets prescribed conditions, added benefit is offered. . . .*" (see Inamitsu (col. 3, ll. 5-20)) and because the combination of the Inamitsu and Tedesco references would have provided means for "*permitting customers to participate in a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.*" (See Tedesco (col. 2, ll. 20-27)). Furthermore, the instant invention would have been rendered obvious over Inamitsu and/or Inamitsu in view of Tedesco, because the claims of the instant invention suffer from undue breadth.

RESPONSE TO ARGUMENTS

4. Applicant's arguments (paper filed 7/12/2004) have been considered but are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of rejection presented in this Office action.

CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

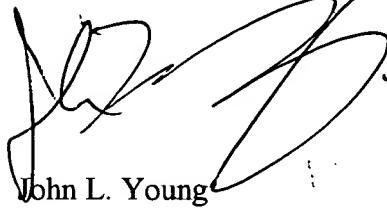
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 305-3900.



JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

August 23, 2004